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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/762,668	01/22/2004	David L. Patton	80521B/F-P	5162								
7590 Pamela R. Crocker Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201		03/14/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">HENDERSON, MARK T</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3722</td><td></td></tr></table>		EXAMINER		HENDERSON, MARK T		ART UNIT	PAPER NUMBER	3722	
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3722												
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE									
2 MONTHS		03/14/2007	PAPER									

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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/762,668
Filing Date: January 22, 2004
Appellant(s): PATTON, DAVID L.

Thomas J. Strouse

Attorney

for Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 19, 2007 appealing from the Office action mailed September 15, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application: 09/534,433

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,120,089	GUTTAG	06-1992
5,601,683	MARTIN	02-1997
* 5,673,338	DENENBERG et al	09-1997
* 6,771,796	RHOADS	08-2004

* Note that the references used as indicated, were only used as rebuttal references to support a questioned inherent limitation of the primary reference as stated in previous office action. These references were not used as a secondary references in examiner's rejection.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Whether claims 1, 2, 4-6 and 8 are rejected under 35 U.S.C. 103(a) over Gutttag in view of Martin.

(10) Response to Argument

In response to appellant's argument that the Gutttag reference "fails to teach or suggest at least a second indicia which is not capable of being scanned (note, appellant does disclose in specification that indicia can not be scanned for reproduction) and is further not visible under normal viewing conditions for confirming that said limited edition official stamp is a valid limited edition official postal stamp" and a "third indicia for identifying a printer an/or location", the examiner submits that Gutttag does indeed disclose a philatelic item being an official postage stamp (see Col. 1, lines 10-42, as well as Col. 2, line 45) having a first visible indicia and an inherent "second indicia". For this inherency teaching, appellant is respectfully requested to review the teachings of Denenberg (used as a rebuttal reference as mentioned above to prove

inherency), which teaches a postage stamp (see Claim 9) having unique indicia (see Col. 3, lines 10-26) which is not capable of being scanned for reproduction (see Col. 3, lines 55-59; also Col. 5, lines 37-55; Col. 1, lines 28-35; and Col. 3, lines 23-26). Simple microscopic (not visible under normal viewing conditions) irregularities in the ink, bubbles in the ink and/or fibers of the paper, at least on of which is inherent in the stamp of Guttag, each define an "indicia" not capable of being scanned for reproduction. In as much set forth by appellant in the claim, this "second indicia", inherent in Guttag, meets the claimed limitations (see MPEP 2111). Further in line with the teachings of Denenberg, the Guttag stamp inherently includes indicia which is consistent with the printer from which it was printed. It is very well known that printers are each unique and contain "flaws" or "imperfections" unique to each printer wherein the print acts as a pseudo fingerprint. This fingerprint is analogous to that of a firearm. When a bullet is fired, a unique pattern is provided on the bullet, which identifies a single firearm. In as much set forth as to the type/structure of the indicia in the claim, such "fingerprints" are inherent to the printer, which forms the stamp defining the third indicia. As an alternative support reference (as mentioned above), the Rhoads reference also discloses that printers are each unique and place "forensic tracer data" with the indicia printed that are unique to each printer, wherein the indicied print acts also as a microscopic fingerprint (as stated in the abstract). In as much set forth as to the type/structure of the indicia in the claim, such "tracer data" are inherent to the printer, which forms the stamp defining the third indicia. In regards to wherein the second indicia is "for confirming that the limited edition official postal stamp is a valid limited edition official postal

stamp”, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the second indicia of Gutttag can be used for confirming whether the stamp is valid.

In regards to applicant’s argument’s that the Martin reference does not disclose “a second indicia not capable of being scanned under normal viewing conditions”, the examiner submits that the Martin reference is only disclosed for the use of UV ink which is not viewable under normal viewing conditions (only seen with a black light) to distinguish itself from pigment based ink and is not capable of being scanned for reproduction (exact duplication) and is particularly used in the background of an item which prevents photocopying. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gutttag’s stamp (with support from Deneberg or Rhoads) with a second indicia, or indicia having additional copy preventing measures such as UV ink as taught by Martin for preventing fraudulent copies. Furthermore, the process wherein the second indicia is made using an ink that can be seen when viewed under UV or infrared light does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113).

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Therefore, it would be obvious to make the second indicia using any ink as desired by the end user to achieve a desired result.

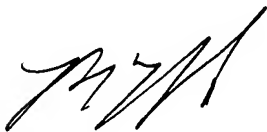
Therefore, the rejection has been maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M Henderson', with a stylized flourish at the end.

Mark Henderson

Examiner/ Art Unit 3722

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Conferees:


Monica S. Carter

Supervisor/ Art Unit 3722

TQAS TC 3700


Greg Vidovich

Supervisor/ Tech 3700